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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re the Application of:

**MURPHY, David, et al.**

**Serial No.:** 10/734,726

**Filed:** December 12, 2003

**For: DEPLOYABLE TRUSS HAVING  
SECOND ORDER  
AUGMENTATION**

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) **Group Art Unit:** 3637  
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) **Examiner:** Phi D. A.  
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**RESPONSE TO RESTRICTION REQUIREMENT**

Commission for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the election/restriction requirement mailed February 13, 2006, Applicants provisionally elects specie 17 with traverse. Specie 17 is identified in the Office Action as the specie of Figure 14. The claims that read on the provisionally elected specie 17 are claims 1, 2, 3, 7, 8, 9, 10, 13, 19-25, and 40.

Applicants traverse the election/restriction requirement because it fails to make out a prima facie case that an election/restriction requirement is proper. In addition, the Office Action fails to appreciate that the claims directed to a combination and subcombination are related inventions.

**CERTIFICATE OF MAILING**  
(37 C.F.R. § 1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

March 13, 2006  
Date of Deposit  
LAI-2232280v1

David A. Randall

Name of Person Mailing Paper

David A. Randall  
Signature of Person Mailing Document

As an initial matter, there are two criteria for a proper restriction requirement between patentably distinct inventions:

- 1.) The inventions must be independent or distinct as claimed; and
- 2.) There would be a serious burden on the examiner if restriction is not required.

*See* MPEP § 808.

Here, the Office Action is completely silent as to both requirements, and thus fails to make out a *prima facie* restriction requirement. Moreover, as noted in MPEP § 806.04(f), for claims to be properly restricted between species, the claims must not overlap in scope. Thus, even though claims 4-6 and 11, 12 and 14-18 do not read on the provisionally elected specie 17, they are not restrictable under MPEP § 806.04 because they overlap in scope with claims that do read on the elected specie. For example, claims 4-6 overlap with the scope of claim 3. Further, claims 11 and 12 overlap with the scope of claim 8. Finally, claims 14-18 overlap with the scope of claim 8. In particular, claims 14-18 are directed to column assemblies with multiple spacers, whereas claim 8 and its dependent claims only require a single spacer, but do not exclude multiple spacers.

Contrary to the statement in the Office Action, the present application does contain a number of generic claims that are readable on multiple species, including, for example, claims 1 and 40. Further, a number of the dependent claims identified above as readable on specie 17 are also readable on a number of the other identified species. Accordingly, Applicants reserve the right to pursue all claims falling within the scope of an allowable generic claim.

The Office Action also fails to provide a proper basis for restricting claims drawn to a combination and corresponding subcombination. Claims 26-39, for example, are directed to column assemblies for a deployable truss and are thus directed to a subcombination of the

combination, namely a deployable truss comprising column assemblies, claimed in claims 1-26 and 40. To properly restrict between combination and subcombination inventions, two-way distinctiveness must be shown and reasons for insisting on the restriction are necessary. MPEP § 806.05. The Office Action is devoid of any showing that the claimed combination and subcombinations are distinct as required by MPEP 806.05(c) or that the inclusion of both the combination and subcombination claims in the application would cause a serious search burden. Accordingly, restriction between the combination claims of 1-25 and 40 and the subcombination claims 26-39 is improper.

In view of the foregoing, reconsideration and withdrawal of the election/restriction requirement are earnestly solicited.

Respectfully submitted,

JONES DAY

Dated: March 13, 2006

By: 

David A. Randall  
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**TRANSMITTAL LETTER**
 Commission for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Response to Restriction Requirement for the above-identified application. The enclosed Response is being filed in response to the Office Action mailed February 13, 2006.

- ☐ Applicant(s) petitions for an extension of time under 37 CFR § 1.136 [fees: 37 CFR § 1.17(a)(1)-(5)] for the total number of months checked below:

<b>EXTENSION (months)</b>		<b>FEE FOR SMALL ENTITY</b>		<b>FEE FOR OTHER THAN SMALL ENTITY</b>
1 month	<input type="checkbox"/>	\$60.00	<input type="checkbox"/>	\$120.00
2 months	<input type="checkbox"/>	\$225.00	<input type="checkbox"/>	\$450.00
3 months	<input type="checkbox"/>	\$510.00	<input type="checkbox"/>	\$1,020.00
4 months	<input type="checkbox"/>	\$795.00	<input type="checkbox"/>	\$1,590.00

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 (37 C.F.R. § 1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

March 13, 2006

 Date of Deposit  
 LAI-2232289v1

David A. Randall

Name of Person Mailing Paper

Signature of Person Mailing Document

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.
- ☐ Extension fee due with this Request \_\_\_\_\_.
- ☒ If an additional extension of time is required, please consider this a petition therefor.

**FEES FOR CLAIMS:**

The fees for claims (37 CFR § 1.16(b)-(d)) have been calculated as shown below:

Total Claims	-	20	=	0	x	\$50.00	\$0.00
Independent Claims	-	3	=	0	x	\$200.00	\$0.00
Multiple Dependent Claims	\$360	(if applicable)				<input type="checkbox"/>	\$0.00
<b>TOTAL OF ABOVE CALCULATIONS</b>							\$0.00
Reduction by ½ for Filing by Small Entity. Note 37 CFR §§ 1.9, 1.27, 1.28. If applicable, Verified Statement must be attached.							\$0.00
<b>TOTAL FEES FOR CLAIMS SUBMITTED HERewith</b>							\$0.00

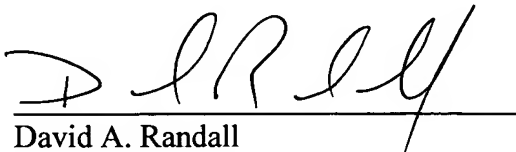
- ☐ A check in the amount of \_\_\_\_\_ is enclosed to cover the above fee(s).
- ☐ Charge Jones Day's Deposit Account No. **50-2468** in the amount of \_\_\_\_\_.
- ☒ The Commissioner is authorized to charge Jones Day's Deposit Account No. **50-2468** for any fees required under 37 CFR §§ 1.16 and 1.17 that are not covered, in whole or in part, by a check enclosed herewith and to credit any overpayments to said Deposit Account **50-2468**.

Respectfully submitted,

JONES DAY

Dated: March 13, 2006

By:

  
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